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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,701	11/17/2003	Don W. Klein	043822-0104	5381

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EXAMINER
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LARSON, JUSTIN MATTHEW

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/714,701

Applicant(s)

KLEIN, DON W.

Examiner

Justin M. Larson

Art Unit

3727

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 14 is objected to because of the following informalities: In line 5, the straps are said to "extend on opposites of the mirror." Examiner assumes that this is meant to read, "extend on opposite sides of the mirror." Appropriate correction is required.
2. Claim 37 is objected to because of the following informalities: Lines 7-8 currently read "at least one of a pocket of a holder of the storage member." Examiner assumes that this is meant to read "at least one of a pocket *or* a holder of the storage member."

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.
4. Claims 9, 12, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, 12, 27 recite the limitation "the at least one elastomeric member" in lines 1-2, 2-3, and 1-2, respectively. There is insufficient antecedent basis for this limitation in the claims.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-7, 10, 11, 15, 19, 22-25, 28, 32, and 36 are rejected under 35

U.S.C. 102(b) as being anticipated by Shikler (US 5,329,947).

Regarding claims 1, 19, and 36, Shikler discloses a container accessory for use with a vehicle component that pivots between a raised position and a lowered position, the accessory comprising: at least one panel (the at least one panel comprising two panels 12&24) configured to be coupled to the component, wherein the at least one panel (12) includes at least one holding mechanism (16).

The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Shikler which is capable of being used in the intended manner, i.e., the at least one panel (24) pivoted between a stowed position in which the at least one panel (12) extends parallel to the component along a bottom side of the component when the component is in the raised position and a deployed position in which the at least one panel (24) extends downwardly from the component when the component is in the raised position. There is no structure in Shikler that would prohibit such functional intended use (see MPEP 2111). Note that is the Shikler device is mounted on the opposite side of the visor as shown, it functions the same as the claimed invention.

Regarding claims 4 and 22, the holding mechanism (16) of Shikler can hold or contain cosmetics, effectively satisfying the limitations of the claim.

Regarding claims 5 and 23, the zippers (51) of Shikler act as a means for releasably retaining the at least one panel (12&24) in the stowed position, effectively satisfying the limitations of the claim.

Regarding claims 6 and 24, the panels (12&24) of Shikler pivot about a living hinge (24), effectively satisfying the limitations of the claim.

Regarding claims 7 and 25, the device of Shikler comprises at least one member (54) coupled to the at least one panel (12) that is configured to at least partially extend about the vehicle component, effectively satisfying the limitations of the claim.

Regarding claim 10, the vehicle component of Shikler comprises a vehicle sun visor and the accessory of Shikler is coupled to the visor, effectively satisfying the limitations of the claim.

Regarding claims 11 and 28, the vehicle component of Shikler pivots about a first axis between the raised position and the lowered position, and the at least one panel (24) pivots about a second axis between the stowed and the deployed position, the second axis extending parallel to the first axis, effectively satisfying the limitations of the claim.

Regarding claims 15 and 32, the claims define the same structural relationships as established in claims 1 and 19, and further require that the second panel include a pocket or second holding mechanism. The device of Shikler includes a zippered pocket on the second panel (24), effectively satisfying the limitations of the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 9, 12-14, 20, 27, 30, 31, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shikler as applied in paragraph 6 above in view of Drew (US 5,762,246).

Regarding claims 2 and 20, Shikler discloses essentially the claimed invention, however, the first panel (12) of Shikler cannot be pivoted away from the vehicle's sun visor like that of the present invention, and therefore, Shikler's device is incapable of operating in a fully deployed state in which both the first panel and the second panel extend downwardly from the component when the component is in the raised state.

Drew, however, also discloses a visor attachment where a panel is held against a vehicle sun visor and teaches that it is desirable to make this panel pivotable with respect to the visor so that when mounted on the top of the visor, a user can still access the vanity mirror located on the visor itself. Therefore, it would have been obvious to one having ordinary skill at the time the invention was made to make the first panel of Shikler pivotable with respect to the visor, as taught by Drew, allowing a user to access the visor's mirror. This modified Shikler attachment would be perfectly capable of the fully deployed state.

Regarding claims 9, 12, 27, and 29, when making the first panel of Shikler pivotable as taught by Drew, it also would have been obvious to one having ordinary

skill in the art to use the hook-and-loop type fasteners (52&54) of Drew on the straps of Shikler so that when the first panel is not pivoted up and away from the visor, it is somehow retained flat against the visor. These hook-and-loop type fasteners effectively satisfy the retainer limitation of the claim.

Regarding claims 13 and 30, the modified Shikler device is capable of the fully stowed state, the intermediate state, and the fully deployed state, and also includes a mirror (36, Shikler). Although Shikler shows the mirror on the second panel (24), rather than the first panel such that the first panel extends between the mirror and the visor when the visor is in the raised position, it would have been obvious to one having ordinary skill in the art at the time the invention was made to move the mirror to another location, such as the first panel, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Note that the location of the mirror is not critical to the function of the invention.

Regarding claims 14 and 31, Drew shows that such vehicle components, i.e. visors, are known to have mirrors that are adapted to face a headliner of the vehicle when the visor is in the raised position. Drew also shows that the his straps, just like the straps of the modified Shikler device, would extend on opposite sides of the mirror, effectively satisfying the limitations of the claim.

Regarding the method claims, 37-40, the modified Shikler device is capable of being used in the claimed method. The modified Shikler device can be pivoted downward from the sun visor while the sun visor is up and an item can be removed from one of the pockets of the device. The second panel can further be pivoted downward

from the first panel while the devices as a whole, i.e. both panels, are pivoted downward from the visor. The sun visor itself can be pivoted downward while either or both panels are in their deployed position.

9. Claims 3, 16-18, and 21 are rejected under 35 U.S.S 103 (a) as being unpatentable over Shikler as applied to claims 1 and 19, respectively, in paragraph 6 above in view of Mantis (US 2003/0183667 A1), and further in view of Kunes et al. (US 5,195,668).

Regarding claim 16, Shikler discloses the claimed invention except for a third panel being coupled to the first panel and configured to extend parallel to the component along a top side of the component when the component is in the raised position.

Mantis, however, also discloses a visor attachment (10) which has two panels located on one side of a visor, held to that visor by two straps, and teaches that a third panel (40) can be attached to the opposite side of the visor to provide more storage space. Mantis shows that the third panel is simply mounted to the straps that already extend across the opposite side of the visor from the two existing panels. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a third panel, mounted on the straps on the opposite side of the modified Shikler device, as taught by Mantis, providing a user with more storage space on their sun visor.

Regarding the limitation that requires this third panel be "coupled" to the first panel, Applicant has disclosed that the term "coupled" can mean connected to directly



or indirectly (page 5 of the disclosure). This third panel of the modified Shikler device is connected indirectly to the first panel via the straps that interconnect the two panels, effectively satisfying the limitations of the claim.

Regarding claim 18, as previously mentioned with regard to claims 5 and 23, the device of Shikler includes a fastening mechanism (51) configured to releasably fasten the second panel (24) to the first panel (12) such that the second panel extends substantially parallel to the first panel, effectively satisfying the limitations of the claim.

Regarding claims 3, 17, and 21, Shikler as applied in paragraph 6 above discloses the claimed invention except for a mirror being coupled to the at least one panel and configured to extend along a top side of the component when the component is in the raised position.

Kunes et al., however, discloses a visor attachment comprising essentially three panels, two of which lie beneath the visor and a third which lies on the side of the visor opposite the first two, and teaches that a mirror may be attached to the panel that lies opposite the other two, in addition to storage means (34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach a mirror to the third panel of the modified Shikler device, as taught by Kunes et al., providing a user with a useful mirror, in addition to extra storage space, while the third panel is positioned to face them.

10. Claims 8 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shikler as applied in paragraph 6 above in view of Palmer et al. (US 6,659,529). Shikler

discloses the claimed invention except for the at least one member being at least partially elastomeric.

Palmer et al., however, also discloses a visor attachment and teaches that it is desirable for the straps that attach the device to the visor to be made of elastic so that the attachment fits over a wide variety of sizes or visors (col. 2 lines 52-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the members or straps of Shikler at least partially elastic, as taught by Palmer et al., so that the attachment would fit a wider variety of sun visors.

11. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shikler in view of Drew as applied in paragraph 8 above, and further in view of Mantis (US 2003/0183667 A1).

Regarding claim 33, Shikler in view of Drew discloses the claimed invention except for a third panel being coupled to the first panel and configured to extend parallel to the component along a top side of the component when the component is in the raised position.

Mantis, however, also discloses a visor attachment (10) which has two panels located on one side of a visor, held to that visor by two straps, and teaches that a third panel (40) can be attached to the opposite side of the visor to provide more storage space. Mantis shows that the third panel is simply mounted to the straps that already extend across the opposite side of the visor from the two existing panels. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a third panel, mounted on the straps on the opposite side of the

modified Shikler device, as taught by Mantis, providing a user with more storage space on their sun visor.

Regarding the limitation that requires this third panel be "coupled" to the first panel, Applicant has disclosed that the term "coupled" can mean connected to directly or indirectly (page 5 of the disclosure). This third panel of the modified Shikler device is connected indirectly to the first panel via the straps that interconnect the two panels, effectively satisfying the limitations of the claim.

Regarding claim 35 the modified Shikler device includes a fastening mechanism (51) configured to releasably fasten the second panel (24) to the first panel (12) such that the second panel extends substantially parallel to the first panel, effectively satisfying the limitations of the claim.

12. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shikler, Drew, and Mantis, as applied in paragraph 11 above, and further in view of Kunes et al. Shikler, Drew, and Mantis as applied in paragraph 11 above discloses the claimed invention except for a mirror being coupled to the third panel so as to face away from the component.

Kunes et al., however, discloses a visor attachment comprising essentially three panels, two of which lie beneath the visor and a third which lies on the side of the visor opposite the first two, and teaches that a mirror may be attached to the panel that lies opposite the other two, in addition to storage means (34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach a mirror to the third panel of the modified Shikler device, as taught by Kunes et

al., providing a user with a useful mirror, in addition to extra storage space, while the third panel is positioned to face them.

**Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Friday, 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML  
1/30/06

  
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SUPERVISORY PATENT EXAMINER